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MARSHALL, GERSTEIN & BORUN LLP
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Chicago, IL 60606

In re Application of
VILLARI *et al* :
U.S. Application No.: 10/527,385 :
PCT No.: PCT/EP2003/010097 :
Int. Filing Date: 11 September 2003 :
Priority Date: 13 September 2002 :
Attorney Docket No.: 30882/SCG5204 :
For: FIREPROOF GLAZING UNIT :

DECISION

This decision is in response to the "Renewed Petition under 37 C.F.R. § 1.47(a)" filed with the United States Designated/Elected Office (DO/EO/US) on 04 April 2006.

BACKGROUND

On 24 January 2006, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Petitioners failed to meet item (2) and item (4) of 37 CFR 1.47(a).

On 04 April 2006, the 37 CFR 1.47(b) applicant submitted a renewed petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration executed by an inventor on behalf of the nonsigning inventor, a one-month extension and fee, a statement of facts, and exhibits A - F.

DISCUSSION

The decision dated 24 January 2006 determined that the petitioners failed to satisfy item (2) of 37 CFR 1.47(a) with regards to the nonsigning joint inventor, Albert van Oijen. In addition, the declaration filed in the international application pursuant to PCT Rule 26ter was not directed to the international application as required. As such, item (4) of 37 CFR 1.47(a) was also not satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicants submitted a statement of facts by counsel claiming that a diligent search was made in attempting to locate the nonsigning inventor. Petitioners also referred the undersigned to paragraph eight of the statement of facts by Christine Davids filed in the original petition contending that this shows an explicit refusal by Mr. Van Oijen to cooperate.

Applicants' claim that the nonsigning inventor expressly refused to cooperate will

be discussed first. Section 409.03(d) of the MPEP requires that a copy of the application be presented to the nonsigning inventor prior to acceptance of a refusal. In this case, the purported refusal was made to Ms. Davids on 21 March 2005. However, there was no evidence submitted that a complete copy of the international application was presented to Mr. van Oijen prior to 21 March 2005. The EPO priority document presented to Mr. van Oijen in December 2002 by Mr. Villari is not sufficient to meet this requirement. Accordingly, the purported refusal made on 21 March 2005 is ineffective.

Petitioners also submitted a statement of facts by counsel which included documentary evidence (with accompanying English translations) as evidence of a search for a new address for the nonsigning inventor. This is sufficient evidence to show that a diligent effort was made to locate Mr. van Oijen. This new evidence along with the proof submitted in the initial petition is sufficient to satisfy Item (2) of 37 CFR 1.47(a).

Concerning item (4), petitioners have submitted a new declaration signed by Valentino Villari on behalf of Albert van Oijen. This declaration complies with 37 CFR 1.497(a) and (b) and meets the requirements of MPEP § 409.03(a)(A).

All the requirements of 37 CFR 1.47(a) are now complete.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 11 September 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 04 April 2006.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette. This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

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Albert van Oijen
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In re Application of
VILLARI et al
U.S. Application No.: 10/527,385
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Int. Filing Date: 11 September 2003
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Attorney Docket No.: 30882/SCG5204
For: FIREPROOF GLAZING UNIT

Dear Mr. Van Oijen:

You are named as legal representative of a deceased inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, Albert van Oijen will be designated as an inventor.

As a legal representative of a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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